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Thomas J. Colson

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EXAMINER

WASSUM, LUKE S

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,315	Applicant(s) COLSON ET AL.	
	Examiner Luke S. Wassum	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14,22 and 52-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14,22 and 52-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040308</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Preliminary Amendment

1. The Applicants' preliminary amendment, filed 30 August 2004, has been received, entered into the record, and considered.
2. As a result of the amendment, claims 1-13, 18-21 and 23 have been canceled, claims 14, 15 and 22 have been amended, and new claims 24-51 have been added.

Response to Supplemental Preliminary Amendment

3. The Applicants' supplemental preliminary amendment, filed 6 May 2005, has been received, entered into the record, and considered.
4. As a result of the supplemental amendment, claims 15-17 and 24-51 have been canceled, claims 14 and 22 have been amended, and new claims 52-69 have been added. Claims 14, 22 and 52-69 are now presented for examination.

The Invention

5. The claimed invention is a system and method for analyzing patent documents and calculating a strength value for each patent.

Priority

6. The Applicants' claim to domestic priority under 35 U.S.C. § 120 as a divisional application based on application 09/415,148, filed 8 October 1999, is acknowledged.

Information Disclosure Statement

7. The Applicants' Information Disclosure Statement, filed 8 March 2004, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

Drawings

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: drawing element 98 in Figure 32 (which is also redundant of element 97).

9. The drawings are further objected to because they fail to show necessary textual labels of features or symbols in Fig. 32 as described in the specification. For example, placing a label, "RAM", with element 92 of Fig. 32, would give the viewer necessary

detail to fully understand this element at a glance. A descriptive textual label for each numbered element in these figures would be needed to better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be labeled in the drawing. Optionally, the applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.84(n)(o), recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

10. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 14 and 52-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Regarding claim 14, this claim recites the process of ranking a set of patents according to strength, but fails to recite a tangible result, a requirement for compliance with the provisions of 35 U.S.C. § 101 for a process that can be interpreted as being implemented through software.

For a result to be tangible, it must be more than just a thought or a computation; it must have real-world value rather than an abstract result. For instance, an additional step that included either storing the ranking and/or strength values for the set of patents

in a database, or displaying said ranking and/or strength values for the set of patents to a user would constitute a tangible result. Claim 14, however, merely cites 'assigning a strength ranking' as the result.

This interpretation of 35 U.S.C. § 101 is consistent with the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published on 26 October 2005, which can be found at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf, particularly with respect to ANNEX IV Computer-Related Nonstatutory Subject Matter, beginning on page 50.

14. Claims 52-60, fully incorporating the deficiencies of their parent claim, are likewise rejected.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 14, 22 and 52-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claims 14 and 22 recite the limitation "said group" in the 'analyzing' limitation. There is insufficient antecedent basis for this limitation in the claim.

18. Claims 52-69, fully incorporating the deficiencies of their respective parent claims, are likewise rejected.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

20. Claims 14, 22, 52, 57, 60, 61, 66 and 69 are rejected under 35 U.S.C. 102(a) as being anticipated by **Goffman et al.** (PCT Publication WO 00/75851).

21. Regarding claim 14, **Goffman et al.** teaches a computer-based method for ranking a set of patents according to strength as claimed, comprising:

- a) analyzing said set of patents by consideration of at least one objective parameter of each patent in said group, said at least one objective parameter selected from the group consisting of number of elements in an independent claim of said each patent, and number of linguistic or textual components in at least one independent claim in each patent (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24); and
- b) assigning a strength ranking to said each patent responsive to said analysis, wherein said analyzing and assigning are performed by a general-purpose computer specially programmed to perform said analyzing and assigning (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24).

22. Regarding claim 22, **Goffman et al.** teaches an apparatus for ranking a set of patents according to strength as claimed, comprising:

- a) means for analyzing said set of patents by consideration of at least one objective parameter of each patent in said group, said at least one objective parameter selected from the group consisting of number of elements in an independent claim of said each patent, and number of linguistic or textual components in at least one claim in said each patent (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24); and
- b) means for assigning a strength ranking to said each patent responsive to said analysis, wherein said means for analyzing and said means for assigning are located in at least one general-purpose computer (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the

length of claims such as the number of characters, words and paragraphs;
see also page 20, lines 20-24).

23. Regarding claims 52 and 61, **Goffman et al.** additionally teaches a method and apparatus further comprising:

- a) identifying each independent claim in each said patent (see disclosure that the relative value variables include the total number of independent claims, page 19, lines 1-15);
- b) determining a number of elements in each independent claim (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24); and
- c) for said each patent, identifying a respective first independent claim from among said each independent claim, where said respective first independent claim has a smallest said number of elements and where said steps of identifying each independent claim, determining and identifying a respective first independent claim are performed by said general-purpose

computer (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24).

24. Regarding claims 57 and 66, **Goffman et al.** additionally teaches a method and apparatus further comprising:

- a) identifying at least one independent claim (see disclosure that the relative value variables include the total number of independent claims, page 19, lines 1-15);
- b) identifying said linguistic or textual components in said at least one independent claim (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24);
- c) determining a number of said linguistic or textual components in said at least one independent claim (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value

variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24); and

d) for said each patent, identifying a respective second independent claim from among said at least one independent claim, where said respective second independent claim has a smallest said number of linguistic or textual components and where said steps of identifying at least one independent claim, said identifying components, said determining and said identifying a second independent claim are performed by said general-purpose computer (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24).

25. Regarding claims 60 and 69, **Goffman et al.** additionally teaches a method and apparatus wherein analyzing said set of patents by consideration of number of linguistic or textual components further comprises counting a number of terms in said at least one independent claim in said each patent (see disclosure on page 19, lines 1-18, that a relative value number for a patent can be generated based upon relative value

variables, including measures of the length of claims such as the number of characters, words and paragraphs; see also page 20, lines 20-24).

26. Claims 14 and 22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Applicants' **Admitted Prior Art**.

27. Regarding claim 14, **Admitted Prior Art** teaches a method for ranking a set of patents according to strength, comprising:

- a) analyzing said set of patents by consideration of at least one objective parameter of each patent in said group, said at least one objective parameter selected from the group consisting of number of elements in an independent claim of said each patent, and number of linguistic or textual components in at least one independent claim in each patent (see disclosure that in general, the fewer claim elements or words in a claim, the broader its scope, paragraph [0012]); and

b) assigning a strength ranking to said each patent responsive to said analysis

(see disclosure that the claim structure and scope are two of the criteria that determine the "strength" of a patent, paragraph [0014]).

Admitted Prior Art fails to explicitly teach a method performed on a computer.

However, it is a well settled rule that automating a known manual process that accomplishes the same result would be obvious to an ordinary artisan in order to make the performance of the process less labor intensive and faster. See *In re Venner et al.* (CCPA) 120 USPQ 192.

28. Regarding claim 22, **Admitted Prior Art** teaches an apparatus for ranking a set of patents according to strength as claimed, comprising:

a) means for analyzing said set of patents by consideration of at least one objective parameter of each patent in said group, said at least one objective parameter selected from the group consisting of number of elements in an independent claim of said each patent, and number of linguistic or textual components in at least one claim in said each patent (see disclosure that in

general, the fewer claim elements or words in a claim, the broader its scope, paragraph [0012]); and

- b) means for assigning a strength ranking to said each patent responsive to said analysis, wherein said means for analyzing and said means for assigning are located in at least one general-purpose computer (see disclosure that the claim structure and scope are two of the criteria that determine the "strength" of a patent, paragraph [0014]).

Admitted Prior Art fails to explicitly teach an apparatus comprising a computer.

However, it is a well settled rule that automating a known manual process that accomplishes the same result would be obvious to an ordinary artisan in order to make the performance of the process less labor intensive and faster. See *In re Venner et al.* (CCPA) 120 USPQ 192.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

31. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

32. Claims 53, 54, 58, 59, 62, 63, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goffman et al.** as applied to claims 14, 22, 52, 57, 60, 61, 66 and 69 above.

33. Regarding claims 53, 54, 58, 59, 62, 63, 67 and 68, **Goffman et al.** teaches a computer-based method and apparatus for ranking a set of patents according to strength substantially as claimed.

Goffman et al. does not explicitly teach a computer-based method and apparatus wherein assigning a strength ranking further comprises assigning a higher ranking to a patent with smaller number of elements in its first independent claim, and assigning the highest ranking to the patent with the smallest number of elements in its first independent claim.

These steps would have been obvious to one of ordinary skill in the art at the time of the invention, however, since it was well known in the art that the shorter the independent claims, the broader the coverage provided and therefore the more valuable

the patent (see page 20, lines 20-24), which means that the value of a given patent is defined by its broadest claim, the broadest claim being the shortest independent claim, and therefore a patent whose shortest independent claim is shorter than that of another patent is more valuable and would therefore be assigned a higher strength ranking, and a patent whose shortest independent claim is shorter than that of *all* other claims would therefore be assigned the highest strength ranking.

34. Claims 55, 56, 64 and 65 rejected under 35 U.S.C. 103(a) as being unpatentable over **Goffman et al.** as applied to claims 14, 22, 52, 57, 60, 61, 66 and 69 above, and further in view of **Newman** (U.S. Patent 5,774,833).

35. Regarding claims 55 and 64, **Goffman et al.** teaches a computer-based method and apparatus for ranking a set of patents according to strength substantially as claimed.

Goffman et al. does not explicitly teach a computer-based method and apparatus further comprising determining the number of elements in a claim by counting semicolons.

Newman, however, teaches a computer-based method and apparatus further comprising identifying each semicolon in said each independent claim (see disclosure of the use of semicolons in claims, col. 10, line 61 through col. 11, line 67, and in particular the disclosure regarding the identification of claim elements at col. 11, lines 15-67) and determining a number of said semicolons in said each independent claim, where said identifying and determining are performed by said general-purpose computer (see disclosure of the use of semicolons in claims, col. 10, line 61 through col. 11, line 67, and in particular the disclosure regarding the identification of claim elements at col. 11, lines 15-67), and wherein determining a number of elements in said each independent claim further comprises relating said number of elements in said each independent claim to said number of said semicolons (see disclosure that each claim part is separated by a semicolon, col. 10, lines 66-67; see also disclosure that claim elements never cross claim part boundaries, that is, a colon or semicolon, col. 11, lines 66-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to relate the occurrence of semicolons to the number of claim elements, since semicolons are used to delineate different elements in patent claims (see col. 11, lines 66-67). Combining specific features of the **Goffman et al.** and **Newman** references would have been obvious to one of ordinary skill in the art at the time of the invention since both reference describe systems for performing analysis of patent claims, requiring the parsing of said claims.

36. Regarding claims 56 and 65, **Newman** teaches a computer-based method and apparatus wherein relating said number of elements further comprises adding the number one to said number of said semicolons (see disclosure that all claim parts are separated by semicolons, col. 10, lines 66-67, meaning that there would be one more claim part/element than semicolons).

37. Claims 52-54, 57-63 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' **Admitted Prior Art**.

38. Regarding claims 52 and 61, **Admitted Prior Art** teaches a method and apparatus for ranking a set of patents according to strength substantially as claimed, including determining a number of elements in each claim (see disclosure that the fewer elements in a claim, the broader its scope, paragraph [0012]).

Admitted Prior Art does not explicitly teach a method and apparatus that identifies each independent claim, and subsequently identifies the independent claim with the smallest number of elements.

These steps would have been obvious to one of ordinary skill in the art at the time of the invention, however, since it was well known in the art that the fewer elements in a claim, the broader its scope (see paragraph [0012]), and furthermore that independent claims must contain fewer elements than their respective dependent claims, as well as the fact that claim scope is one criteria that determines the "strength" of a patent (see paragraph [0014]), and finally that a patent's breadth will be determined by its broadest claim, which must necessarily be the broadest independent claim.

Admitted Prior Art fails to explicitly teach an apparatus comprising a computer.

However, it is a well settled rule that automating a known manual process that accomplishes the same result would be obvious to an ordinary artisan in order to make the performance of the process less labor intensive and faster. See *In re Venner et al.* (CCPA) 120 USPQ 192.

39. Regarding claims 57 and 66, **Admitted Prior Art** additionally teaches a method and apparatus further comprising:

- a) identifying said linguistic or textual components in said at least one claim (see disclosure that the fewer words in a claim, the broader its scope, paragraph [0012]); and
- b) determining a number of said linguistic or textual components in said at least one claim (see disclosure that the fewer words in a claim, the broader its scope, paragraph [0012]).

Admitted Prior Art does not explicitly teach a method and apparatus that identifies each independent claim, and subsequently identifies the independent claim with the smallest number of elements.

These steps would have been obvious to one of ordinary skill in the art at the time of the invention, however, since it was well known in the art that the fewer elements in a claim, the broader its scope (see paragraph [0012]), and furthermore that independent claims must contain fewer elements than their respective dependent claims, as well as the fact that claim scope is one criteria that determines the "strength" of a patent (see paragraph [0014]), and finally that a patent's breadth will be determined by its broadest claim, which must necessarily be the broadest independent claim.

Admitted Prior Art fails to explicitly teach an apparatus comprising a computer.

However, it is a well settled rule that automating a known manual process that accomplishes the same result would be obvious to an ordinary artisan in order to make the performance of the process less labor intensive and faster. See *In re Venner et al.* (CCPA) 120 USPQ 192.

40. Regarding claims 53, 54, 58, 59, 62, 63, 67 and 68, **Admitted Prior Art** teaches a method and apparatus for ranking a set of patents according to strength substantially as claimed.

Admitted Prior Art does not explicitly teach a method and apparatus wherein assigning a strength ranking further comprises assigning a higher ranking to a patent with smaller number of elements in its first independent claim, and assigning the highest ranking to the patent with the smallest number of elements in its first independent claim.

These steps would have been obvious to one of ordinary skill in the art at the time of the invention, however, since it was well known in the art that the fewer elements in a claim, the broader its scope (see paragraph [0012]), and that claim scope is one criteria that determines the "strength" of a patent (see paragraph [0014]), which means that the strength of a given patent is at least partially defined by its broadest claim, the broadest claim being the shortest independent claim, and therefore a patent whose shortest independent claim is shorter than that of another patent would therefore be assigned a higher strength ranking, and a patent whose shortest independent claim is shorter than that of *all* other claims would therefore be assigned the highest strength ranking.

Admitted Prior Art fails to explicitly teach an apparatus comprising a computer.

However, it is a well settled rule that automating a known manual process that accomplishes the same result would be obvious to an ordinary artisan in order to make the performance of the process less labor intensive and faster. See *In re Venner et al.* (CCPA) 120 USPQ 192.

41. Regarding claims 60 and 69, **Admitted Prior Art** additionally teaches a method and apparatus wherein analyzing said set of patents by consideration of number of linguistic or textual components further comprises counting a number of terms in said at least one claim in said each patent (see disclosure that the fewer words in a claim, the broader its scope, paragraph [0012]).

Admitted Prior Art does not explicitly teach a method and apparatus that identifies each independent claim.

These steps would have been obvious to one of ordinary skill in the art at the time of the invention, however, since it was well known in the art that the fewer elements in a claim, the broader its scope (see paragraph [0012]), and furthermore that independent claims must contain fewer elements than their respective dependent

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claims, as well as the fact that claim scope is one criteria that determines the "strength" of a patent (see paragraph [0014]), and finally that a patent's breadth will be determined by its broadest claim, which must necessarily be the broadest independent claim.

Admitted Prior Art fails to explicitly teach an apparatus comprising a computer.

However, it is a well settled rule that automating a known manual process that accomplishes the same result would be obvious to an ordinary artisan in order to make the performance of the process less labor intensive and faster. See *In re Venner et al.* (CCPA) 120 USPQ 192.

42. Claims 55, 56, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Admitted Prior Art** as applied to claims 52-54, 57-63 and 66-69 above, and further in view of **Newman** (U.S. Patent 5,774,833).

43. Regarding claims 55 and 64, **Admitted Prior Art** teaches a method and apparatus for ranking a set of patents according to strength substantially as claimed.

Admitted Prior Art does not explicitly teach a method and apparatus further comprising determining the number of elements in a claim by counting semicolons.

Newman, however, teaches a computer-based method and apparatus further comprising identifying each semicolon in said each independent claim (see disclosure of the use of semicolons in claims, col. 10, line 61 through col. 11, line 67, and in particular the disclosure regarding the identification of claim elements at col. 11, lines 15-67) and determining a number of said semicolons in said each independent claim, where said identifying and determining are performed by said general-purpose computer (see disclosure of the use of semicolons in claims, col. 10, line 61 through col. 11, line 67, and in particular the disclosure regarding the identification of claim elements at col. 11, lines 15-67), and wherein determining a number of elements in said each independent claim further comprises relating said number of elements in said each independent claim to said number of said semicolons (see disclosure that each claim part is separated by a semicolon, col. 10, lines 66-67; see also disclosure that claim elements never cross claim part boundaries, that is, a colon or semicolon, col. 11, lines 66-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to relate the occurrence of semicolons to the number of claim elements, since semicolons are used to delineate different elements in patent claims (see col. 11, lines 66-67). Combining specific features of the **Admitted Prior Art** and **Newman** references would have been obvious to one of ordinary skill in the art at the time of the invention since both reference describe systems for performing analysis of patent claims, requiring the parsing of said claims.

44. Regarding claims 56 and 65, **Newman** teaches a computer-based method and apparatus wherein relating said number of elements further comprises adding the number one to said number of said semicolons (see disclosure that all claim parts are separated by semicolons, col. 10, lines 66-67, meaning that there would be one more claim part/element than semicolons).

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Unger et al. (U.S. Patent 5,721,910) teaches a database that can be used to determine the meaning of scientific or technical documents, such as patents.

Rivette et al. (U.S. Patent 5,754,840) teaches a method for assisting in the preparation of a document, and for analyzing the document, such as a patent or patent application.

Donner (U.S. Patent 5,999,907) teaches an intellectual property computer-implemented audit system for valuing an intellectual property portfolio.

Rivette et al. (U.S. Patent 6,014,663) teaches a method for assisting in the preparation of a document, and for analyzing the document, such as a patent or patent application.

Snyder et al. (U.S. Patent 6,038,561) teaches a system for analyzing and displaying information contained in a plurality of documents such as patents.

Donner (U.S. Patent 6,154,725) teaches an intellectual property computer-implemented audit system for valuing an intellectual property portfolio.

Donner (U.S. Patent 6,263,314) teaches a method of performing an intellectual property audit which estimates the value of an intellectual property portfolio.

Hunter et al. (U.S. Patent 6,298,327) teaches an expert support system for authoring invention disclosures.

Barney et al. (U.S. Patent 6,556,992) teaches a statistical patent rating system.

Carter (U.S. Patent 6,665,656) teaches a method for producing correlating information with respect to a target document, such as a patent.

Lindh (U.S. Patent Application Publication 2002/0022974) teaches a method for obtaining patent information across a multitude of databases.

Del Vecchio et al. (U.S. Patent Application Publication 2003/0036945) teaches a method of assessing the value of a company's intellectual property.

Whewell et al. (U.S. Patent Application Publication 2004/0205599) teaches a method for producing a patentability search report.

Barney (U.S. Patent Application Publication 2004/00220842) teaches a statistical patent rating system.

Lin et al. (U.S. Patent Application Publication 2005/0004806) teaches a method for analyzing a claim in a patent or patent application.

Hagelin (U.S. Patent Application Publication 2005/0149420) teaches a method of calculating the value of a license for an intellectual property asset.

Hodes (U.S. Patent Application Publication 2005/0234738) teaches a system using one or more ontologies to perform patent analysis and formulation.

Williams (U.S. Patent Application Publication 2006/0036452) teaches a method for evaluating a portfolio of patent documents for patent quality.

Williams (U.S. Patent Application Publication 2006/0036453) teaches a method for evaluating a portfolio of patent documents for patent quality.

Williams (U.S. Patent Application Publication 2006/0036529) teaches a method for evaluating a portfolio of patent documents for patent quality.

Williams (U.S. Patent Application Publication 2006/0036632) teaches a method for evaluating a portfolio of patent documents for patent quality.

Williams (U.S. Patent Application Publication 2006/0036635) teaches a method for evaluating a portfolio of patent documents for patent quality.

Motorola ("Seven Sigma Expert System Electronic Reviewer") teaches a system for aiding patent attorneys to identify various errors in patent applications.

Motorola ("Epidigm™ Patent Application Checker Version 1.1.1") teaches a system for aiding patent attorneys to identify various errors in patent applications.

Plurality™ Corporation ("The Examiner Software") teaches a system for aiding patent attorneys to identify various errors in patent applications.

Aharonian ("PATNEWS: Version 0 of my Patent Claims Analysis Program") teaches the availability of a patent claims analysis program.

Sheremetyeva et al. ("Generating Patent Claims from Interactive Input") teaches a system for supporting the authoring of claims for patents.

Neifeld et al. ("System and Method of Estimating Values of an Organization's Patent Portfolio") is a U.S. Provisional Patent Application.

Aharonian ("PATNEWS: Free Patent Claims Analysis Tool from PATNEWS") teaches the availability of a patent claims analysis tool.

Patent Harvest ("Identifying, Assessing and Detailing "Diamond" (High-Value) Patents") teaches a system for performing patent analysis.

Sheremetyeva ("Natural Language Analysis of Patent Claims") teaches an NPL methodology for analyzing patent claims.

Lau ("Patent Tools") is a website that provides a variety of patent analysis tools.

Gibbs ("PatentCafe's New Online Tools Analyze Patent Value") teaches new patent analysis tools available from the PatentCafe website.

Wagner ("The Patent Quality Index") is a slide presentation regarding a proposed patent quality index.

Ocean Tomo ("Ocean Tomo Patent Ratings") teaches a system for analyzing patents and producing ratings.

Wagner ("The Patent Quality Index: Frequently Asked Questions") teaches a proposed patent quality index.

Telaric ("Telaric Patent Examiner: Rationale for Use Guide") teaches a system for aiding patent attorneys to identify various errors in patent applications.

Telaric ("Telaric Patent Examiner: Getting Started Guide") teaches a system for aiding patent attorneys to identify various errors in patent applications.

PatentCafe ("Generate a Patent Value Report") teaches a system for determining a patent's estimated value.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
10 August 2006